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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,070	12/08/1998	SHUSOU WADAKA	2565-136P	2419

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EXAMINER

BUDD, MARK OSBORNE

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 207070	Applicant(s) Wadaka et al
Examiner M. Budd	Group Art Unit 2834

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 10-17-02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) _____ is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))
- *Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other Examiners Answer

Office Action Summary

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This is in response to the brief on appeal filed .

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

Claims 47-62 withdrawn from consideration as not directed to the elected .

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims do not stand or fall together and provides reasons as set forth in 37 CAR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5194836 Vale et al 3-93

5185589 Krishnaswamy et al 2-93

5-259804 Japan 10-93

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 42-46 and 2-14 are rejected under 35 U.S.C. 102 as anticipated by Krishnasawamy (figs. 1-5 and 7), Curran (fig. 8), Vale (figs. 1 and 2) or Japan (804) (fig. 4). Each reference explicitly teaches the structure claimed. For example, fig. 7 of Krishnasawamy teaches a wafer #57, #53, a ground electrode #56, #52, a piezoelectric thin film #51, #55 and an upper electrode #50, #54. Vale (figs 1 and 2) shows wafer #30, #70, piezo wafer #85, a bottom electrode #80 and a top electrode #90. Curran (fig. 8) teaches wafer #24, common electrode #30, #32, piezoelectric thin elements #26 and top electrodes #28. Japan (804) (figs. 4 and 5) shows bottom electrode #4, piezo resonator #2 (thin portion), wafer #3 (thick portion) and top electrode #6, #7, #8, #9.

Claims 2-14 and 42-46 are rejected under 35 U.S.C. 102 as anticipated by Krishnasawamy (Figs. 1-5 and 7), Corran (Fig. 8), Vale (Figs. 1 and 2) or Japan (804) (Fig. 4). Each reference teaches the claimed structures. Note that the "wherein at least one component --- on the wafer" is merely a statement of desired function adding no structure to the device claimed.

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It has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957).

The functional "wherein" recitations have not been given patentable weight because they are narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC 112 and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. In re Fuller, 1929 C.D. 172; 388 O.G. 279. It has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. In re Hotte, 177 USPQ 326, 328 (CCPA 1973). It is also noted that the method of forming a device is not germane to the patentability of the device itself.

Each reference obviously designs the resonator chips with a final frequency in mind and then fine tunes the device (usually thru additional ore removed of material) to compensate for the deviations in manufacture. Once the final tuning is achieved one cannot tell where metal was deleted or added or how much. Thus statement, referring to the desire to adjust to e.g. the final frequency based on wafer position are meaningless in a finished article claim.

For any transducer designed, the electrode pattern and placement on the substrate are "determined" at some point. Even assuming arguendo that this "where in" phraseology does determine some structure it would be impossible to determine the identical final products even if their electrode positions were "determined" by a different rational. Regardless, note Japan (804) (Fig. 4), the resonators 5 and 5' have different shapes at different substrate locations. In Curran,


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resonators A, B and C each have a different frequency thus they must be structurally different at different locations. Note they are also located a distance from each other to avoid interference: thus positions determined---". The same argument holds true for Krishnasawamy and Vale (note the leads are different for #15, #20 and #25 as "determined by their location on the substrate---".


(11) Response to Argument


The grounds for final rejection are seen to answer and rebut applicants arguments. Applicant and the examiner simply disagree on whether or not the "wherein" statements or "method of manufacturing" recitation are to be considered "structural" device or article claimed. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


MARK U. BUDD
PRIMARY EXAMINER
ART UNIT 212

December 6, 2001

Conferees 

N. Rameriz 

K. Tamai